

Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

8350.2341

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

10/653,353

Filed

August 28, 2003

First Named Inventor

William Charles Sahn

Art Unit

2636

Examiner

B. Swarthout

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☐

attorney or agent of record.

Registration number \_\_\_\_\_

☒

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 41,450

Signature

Roland G. McAndrews

Typed or printed name

202.408.4469

Telephone number

August 4, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐

\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PATENT  
Customer No. 22,852  
Attorney Docket No. 8350.2341

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	)	
	)	
William Charles SAHM et al.	)	Group Art Unit: 2636
	)	
Application No.: 10/653,353	)	Examiner: B. Swarthout
	)	
Filed: August 28, 2003	)	
	)	Confirmation No.: 3027
For: WORK MACHINE DISPLAY	)	
SYSTEM	)	

**Mail Stop AF**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Applicants request a pre-appeal brief review of the rejections applied against this application in the final Office Action dated May 4, 2005. This Request is being filed concurrently with a Notice of Appeal.

**I. Compliance With Requirements For Submitting a Pre-Appeal Brief Request for Review**

This submission complies with the requirements for requesting a pre-appeal brief review because: (1) the present application has been at least twice rejected; (2) this Request is being filed concurrently with a Notice of Appeal prior to the filing of an Appeal Brief; and (3) this Request is five (5) or less pages in length and sets forth legal and/or factual deficiencies in the outstanding final rejections. See Official Gazette Notice, July 12, 2005.

**II. Status of the Claims**

In the outstanding final Office Action claims 1-21 stand finally rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,047,227 to Henderson et al. ("Henderson") in view of U.S. Patent No. 4,807,131 to Clegg ("Clegg").

**III. Grounds for Traversing Final Rejection**

***A Prima Facie Case of Obviousness Has Not Been Established In Rejecting Claims 1-21 Under 35 U.S.C. § 103(a) as Obvious Over Henderson in View of Clegg***

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness in rejecting claims 1-21 over Henderson in view of Clegg because neither Henderson nor Clegg, alone or in combination, disclose or suggest each of the limitations recited in pending claims 1-21 of this application. In particular, with respect to independent claim 1, neither Henderson nor Clegg disclose or suggest, for example, the claimed method of displaying positional information for a work machine including displaying a terrain map having "a plurality of elevation segments, each of the plurality of elevation segments having an actual surface elevation value for a discrete area of the geographic location." For this reason, Applicants request that this application be allowed.

In the final Office Action, the Examiner contends that Fig. 4 of Clegg "discloses a display device showing [a] work tool with respect to a terrain map, wherein the map includes plural terrain elevations." (Final Office Action at page 2.) Applicants disagree with this interpretation of Clegg and submit that Fig. 4 of Clegg does not disclose a display device. Clegg describes Fig. 4 as depicting a vertical profile of a *portion of the tract* of Fig. 3 taken along lines 4--4 of Fig. 3. (Clegg, col. 13, ll 53-60.) Fig. 3 of Clegg

is described as "a plan view of a *building site tract*, of a type which may be graded according to the principals of this invention" (Clegg, col. 10, ll 36-38.) Clegg does not state that Fig. 4 is a display device, nor that the information depicted in the figure is shown on a display device. In view of this, Applicants submit that Fig. 4 of Clegg is an actual profile view of a portion of the land or tract shown in Fig. 3, not a display.

Furthermore, there is no support in Clegg for the Examiner's contention on page 5 of the final Office Action that "the profile in FIG. 4 is displayed on display 320 in FIG. 4, including tool elevation, preferred grade elevation 322, and tolerance elevations 324, 326." These reference numbers cited by the Examiner are not included in Fig. 4 and are not mentioned in the specification in connection with Fig. 4. (See Clegg, col. 10, ll 39-43; col. 13, ll 50-68; col. 14, ll 1-23; col. 18, ll 58-68; and col. 18, ll 1-12.) The reference numbers associated with Fig. 4 (i.e., 192-196, 201, 203, 205) are all included in Fig. 3, which, as noted above, is a depiction of an actual portion of land or tract not a display.

In an attempt to explain away the deficiencies in Clegg, the Examiner points to Fig. 5 of Clegg and makes the following statements:

"Clegg discloses plural elevations of a geographic site can be displayed relative to tool elevation 328 (FIG. 5). As shown in the Figure, 322 represents a desired elevation to be graded, and 324 and 326 represent elevation slightly below and above the preferred elevation. Thus, Clegg clearly satisfies the claim limitation of displaying plural elevation segments." (Final Office Action at page 2.)

Applicants submit that the Examiner continues to mischaracterize the Clegg reference. For example, Fig. 5 of Clegg discloses a display monitor 320 having a reference line 322 representing slope and elevation of the desired grade, lower and upper tolerance lines 324 and 326, and a dashed line or other line 328 depicting to

scale the elevation and slope of the cutting blade. (Clegg, col. 23, ll 40-48.) Fig. 5 of Clegg does not disclose a display of a terrain map including a plurality of elevation segments, each of the plurality of elevation segments having an *actual* surface elevation value for a discrete area of the geographic location, as recited in independent claim 1. None of the lines 322, 324, 326, or 328 of Clegg, whether taken alone or in combination, are a plurality of elevation segments, with each of the plurality of elevation segments having an actual surface elevation value, as recited in independent claim 1. In contrast, Clegg specifically discloses that lines 322, 324, 326, and 328 are *not* actual surface elevation values for a discrete area of the geographic location, but rather, represent the desired grade, tolerance lines, and cutting blade slope, respectively.

Fig. 5 of Clegg discloses a video monitor 330 showing contours of the tract before grading by means of contour lines 332, the location of the various pads and roads or other portions of the tract by dashed or other distinct lines 334 and the location and direction of travel of the earth mover on the tract by an arrow or other marker 336. (Clegg, col. 23, lines 49-56.) Similar to lines 322, 324, 326, and 328 discussed above, none of the lines 330, 332, or 334 of Clegg, whether taken alone or in combination, are a plurality of elevation segments, with each of the plurality of elevation segments having an actual surface elevation value, as recited in independent claim 1.

Applicants submit that Henderson does not overcome the deficiencies noted above with respect to Clegg. In particular, Henderson does not disclose or suggest the “plurality of elevation segments, each of the plurality of elevation segments having an actual surface elevation value for a discrete area of the geographic location” recited in independent claim 1. The Examiner appears to agree with this interpretation of

Henderson with the statement that Henderson discloses certain features "except for specifically stating that the terrain map includes a plurality of elevation segments." (final Office Action at page 2.)

Independent claims 8, 14, and 21 each recite a display of a terrain map including "a plurality of elevation segments, each of the plurality of elevation segments having an actual surface elevation value for a discrete area of the geographic location."

Accordingly, for the same reasons presented above, Henderson and Clegg fail to disclose each of the limitations recited in these claims.

In light of the above arguments and those presented in the Amendment filed April 11, 2005, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness in rejecting independent claims 1, 8, 14, and 21, and the dependent claims 2-7, 9-13, and 15-20 that depend either directly or indirectly therefrom.

Therefore, the rejections should be withdrawn and the claims allowed.

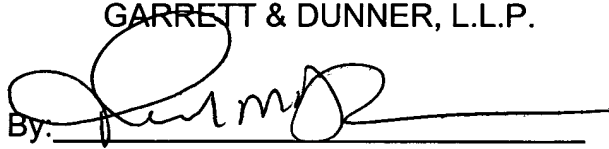
#### **IV. Conclusion**

Because the Examiner's rejections of claims 1-21 include legal deficiencies with regard to 35 U.S.C. § 103(a), Applicants are entitled to a pre-appeal brief review of the Final Office Action. Based on the foregoing arguments, Applicants request that the rejection of these claims be withdrawn and the claims allowed.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: August 4, 2005

By:   
Roland McAndrews  
Reg. No. 41,450